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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,621	01/30/2004	Hidehiko Ogawa	P24510	5645
7055	7590	11/28/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,621

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Thomas D. Lee

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/461,402.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/1/04, 7/6/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☒ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS filed 3/4/05.

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/461,402, filed on December 15, 1999.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Base claims 1 (line 3), 6 (line 3), 11 (line 3), 16 (line 4), 18 (line 4) and 20 (line 4) recites the limitation "the LAN." There is insufficient antecedent basis for this limitation in the claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"

Art Unit: 2624

granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/767,949 in view of U.S. Patent 5,798,845 (Baek). Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences between the pending claims of this application and the pending claims of the co-pending application is that a memory in this application is provided for storing a default mail address, and the default mail address is set into the mail from of an e-mail to which image data is attached when the mail address of a user is not selected by the panel section. However, it is well known in the art that a memory that stores user identification numbers for the transmission of image data can also store a default number, and that this default number can be attached to image information to be transmitted to a receiver when a user identification number is not entered. Baek discloses this limitation (column 7, lines 44-67 (the default number is the automatic dialing number "FF")). It would have been obvious to one of ordinary skill in the art that by providing a default number, a user may be able to transmit image data, either

Art Unit: 2624

on behalf of himself or herself, or on behalf of the company for which he or she works, and that a person receiving the image data can positively identify the company sending the image data even if a user at the transmitting end fails to enter identification information. Furthermore, one of ordinary skill in the art would have been motivated to modify the apparatus or method recited in the co-pending application, in view of Baek, so that any error messages can be communicated to the sending apparatus, even if a user fails to input a mail address.

This is a provisional obviousness-type double patenting rejection.

Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-11, 13-17, 19, 20, 22, 23, 25, 26, 28, 29, 31, 32, 34, 35, 37, 38, 40, 41, 43 and 44 of copending Application No. 10/767,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because entry of a mail address, as recited in this application, is a well-known alternative to accessing the mail address stored in a memory, as recited in the claims of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

Art Unit: 2624

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,742,769 (Lee) in view of Baek and U.S. Publication 2002/0059362 (Maeda).

Regarding claims 1-15, Lee discloses an image data communication apparatus connected to an image data source and to a network, and transmitting an e-mail to a receiving apparatus via the LAN, the e-mail including a mail from command and a mail message (column 7, lines 26-39), the image data communication apparatus comprising: a panel section configured to input a mail address of a user to the image data communication apparatus (in order to log in, a user enters the e-mail address and password for authentication (column 5, lines 7-15)); and a controller configured to set the mail address of the user, input by the panel section, into the mail from command of the e-mail when the mail address of the user is input by the panel section (user's e-mail address copied into "reply-to" field (column 7, lines 36-40), enabling reply from receiving apparatus (column 7, lines 51-59)). The panel section comprises a personal computer connected to the image communication apparatus and displaying an HTML document for storing the mail message of the user in the memory (PENTIUM®-based personal computer running on a 32-bit operating system such as Windows NT (column 3, lines 23-28)).

Lee does not disclose the transmission of image data attached to the e-mail. However, it is well known in the art that image data may be transmitted as

Art Unit: 2624

an attachment to an e-mail message. It is common practice to transmit a document or a picture via e-mail by scanning the document or picture and attaching it to the e-mail, and in such a case the attached document is inherently converted into a format for e-mail transmission. By providing for the transmission of scanned image data as an attachment, a greater variety of image data can be transmitted for immediate reception at the receiving apparatus, and thus it would have been obvious to modify the teaching of Lee by providing a scanner for inputting image data so that the image data may be transmitted as an attachment to an e-mail message, as is well known in the art.

Lee does not disclose a memory configured to store a default mail address, or a controller configured to set the default mail address into the mail from command of the e-mail to which the image data is attached when the mail address of the user is not input by the panel section. However, as mentioned above, it is well known in the art that a memory that stores user identification numbers for the transmission of image data can also store a default number, and that this default number can be attached to image information to be transmitted to a receiver when a user identification number is not entered. Baek discloses this limitation (column 7, lines 44-67 (the default number is the automatic dialing number "FF)). It would have been obvious to one of ordinary skill in the art that by providing a default number, a user may be able to transmit image data, either on behalf of himself or herself, or on behalf of the company for which he or she works, and that a person receiving the image data can positively identify the

Art Unit: 2624

company sending the image data even if a user at the transmitting end fails to enter identification information.

Lee, in combination with Baek, does not disclose the transmission of a mail error message when an error occurs, indicating an error in one of transmission of the e-mail by the image data communication apparatus and reception of the e-mail by the receiving apparatus. This limitation is disclosed in Maeda (as was conventional at the time of Maeda's invention, a reply e-mail (process failure notification) was transmitted from a receiving side to a transmitting side when the receiving side could not process the image file attached to a received e-mail (paragraph (0003))). Transmitting such a reply e-mail enables a user at the transmitting side to recognize that a transmission was unsuccessful, and thus the user will know that steps must be taken in order to assure a successful re-transmission of the e-mail. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Lee and Baek by providing for the transmission of a process failure notification from the receiving apparatus when an error occurs, as was conventionally practiced at the time of Maeda.

Regarding claims 16-21, Lee further discloses a transmitter configured to transmit an e-mail to a receiving apparatus via the LAN, the e-mail including a mail from command and a mail message (column 7, lines 26-35).

Claims 22-33 are method claims corresponding to above-rejected apparatus claims 1, 5, 6, 10, 11, 15 and 16-21, respectively. The method steps



Art Unit: 2624

are either disclosed or suggested by Lee in view of Baek and Maeda, or would have been obvious to one of ordinary skill in the art, as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tdl  
November 22, 2005



THOMAS D.  
~~LEE~~ LEE  
PRIMARY EXAMINER